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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

PHU, SANH D

ART UNIT PAPER NUMBER

2682 //

DATE MAILED: 04/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/817,086

Applicant(s)

SIMON, JEAN-MICHEL

Examiner

Sanh D Phu

Art Unit

2682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This Office Action is responsive to the Amendment filed on 4/1/04.

Specification

1. The Specification and Abstract of amendment, which was filed on 4/1/04, is objected under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

- “an apparatus that avoids the necessity of using a computer for updating operation software within a storage device”; and
- “while the embodiments of the present invention disclosed herein are presently considered to be preferred, various changes and modifications can be made without departing from the spirit and scope of the invention. The scope of the invention is indicated in the appended claims, and all changes that come within the meaning and range of equivalents are intended to be embraced therein”.

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- In Abstract "The operation of the apparatus (1) depends on operation software contained in a storage device (45). It often appears to be necessary to **update the stored operation software**. For this purpose, **update data** contained in another storage device of another apparatus (50), of the same type as the apparatus (1), is tapped by the apparatus (1) for storage within storage device (45). This updating technique for the stored operation software has an application to portable cellular telephony apparatus."

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections – 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1–7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject

matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 recites the limitations “a storage device for **storing operation software**” and “updating means for **updating the operation software stored within said storage device** via an interfacing with another apparatus of the same type”. These limitations are considered new matter because the specification, as originally filed, does not support for such limitations.

Claim 5 recites the limitations “**storing operation software** in a first apparatus” and “tapping update data from a second apparatus of the same type as the first apparatus **to update the operation software in the first apparatus**”. These limitations are considered new matter because the specification, as originally filed, does not support for such limitations.

Claim 7 recites the limitation “means for exchanging update data for **updating operation software stored within a first apparatus** wherein a second apparatus communicates the update data to the first apparatus and the **operation software stored within the first apparatus is updated with the update**”.

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data". This limitation is considered new matter because the specification, as originally filed, does not support for such limitation.

Claims, (if any) depended on above claims, are therefore, also rejected.

The below rejections are assuming that the limitations of the amendment are not new matter.

Claim Rejections - 35 USC 102 & 103

4. The following rejections are assuming that the limitations of the amendment are not new matter.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 1,2, 5-7 are rejected under 35 U.S.C 102(e) as being anticipated by Turner (6,041,229), newly cited.

Regarding to claim 1, Turner disclose an apparatus (2) wherein the apparatus comprises a storage device (23,33) for storing operation software, and updating means (22,23,32,33) for updating (cloning) the operation software stored within said storage device via an interfacing with another apparatus (3) of the same type (compatible)(see col. 4, lines 15-28).

Regarding to claim 2, Turner discloses that said updating means are formed by a serial wire link (transfer the information directly between device (2) and (3)) (see col. 4, lines 46-49).

Regarding to claim 5, Turner discloses a method comprising:

Storing operation software in a first apparatus (2) (see Fig.1); and

Tapping update data from a second apparatus (3) of the same type as the first apparatus (2) to update the operation software in the first apparatus (2).
(Two devices are compatible) (Fig. 1,col. 3 lines 39-43 and col. 4, lines 15 - 28).

Regarding to claim 6, Turner discloses the method wherein tapping update data from a second apparatus of the same type as the first apparatus to update the operation software in the first apparatus includes:

Preparing the second apparatus (faulty phone) for producing the data (see Fig.1),

Preparing the first apparatus (new phone) for receiving the data (see Fig. 1),

Transferring the data from the second apparatus (faulty phone) to the first apparatus (new phone) (see Fig.1),

writing (cloning) data in the storage device of the first apparatus (new phone) (see Fig. 1, col. 4, lines 15-28 and col. 4, lines 46-49).

Regarding to claim 7, Turner discloses a system comprising:

at least two apparatus of the same type (compatible); and

means (22,23,32,33) for exchanging data for updating operation

software stored within a first apparatus, wherein a second apparatus (3)

communicates the data to the first apparatus (2) and the operation software

stored within the first apparatus is updated with the update data (see Fig. 1, col. 4, lines 15-28 and col. 4, lines 46-49).

Claim Rejections – 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Turner (6,041,229) in view of Kadaba et al (6,285,916).

Regarding to claim 3 (see Turner Fig. 1), Turner does not disclose said updating means are formed by an infrared link. But, Turner discloses said updating means are formed by a transfer link as a cable link (4,5) for transferring data from 2 to 3 (see Fig. 1).

Kadaba et al discloses that data can alternatively be transferred by cable link or Infrared link (see Kadaba et al Fig. 1, col. 5, line 12 to 21)

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It would have been obvious for a person skilled in the art to alternatively implement Turner's transfer link as an infrared link so that the two devices (2,3) are capable to transfer data wirelessly without any losing data.

Regarding to claim 4 (see Turner Fig. 1), Turner does not disclose said updating means are formed by a RF link. But, Turner discloses said updating means are formed by (a transfer link as a cable link for transferring data from 2 to 3)

Kadaba et al discloses that data can alternatively be transferred by cable link or RF link (see Kadaba et al Fig. 1, col. 5, line 12 to 21)

It would have been obvious for a person skilled in the art to alternatively implement Turner's transfer link as an infrared link so that the two devices (2,3) are capable to transfer data wirelessly without any losing data.

Response to Arguments

7. Applicant's arguments with respect to claims 1-7 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanh D Phu whose telephone number is (703) 305-8635. The examiner can normally be reached on 8:00-16:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin can be reached on 703-301-6739. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sanh D. Phu
Examiner
Art Unit 2682

Sp


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